

## **REMARKS**

By this Amendment, Applicants propose amending claim 39 to correct a typographical error, as suggested by the Examiner. Claims 29-39 remain currently pending.

In the last Office Action, the Examiner objected to claim 39 because of an informality; rejected claims 29-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,555,098 to Parulski ("Parulski") in view of U.S. Patent No. 6,167,189 to Taira et al. ("Taira"); and rejected claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Taira and in further view of U.S. Patent No. 7,167,635 to Ando et al. ("Ando").<sup>1</sup>

### **Regarding the claim objection**

Applicants propose amending claim 39 to correct the typographical error, as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of the objection to claim 39.

### **Regarding the rejection under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the Examiner's rejection of claims 29-38 under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Taira, because Taira does not qualify as a prior art reference under 35 U.S.C. § 103(c).

35 U.S.C. §103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claim invention were, at the time the claimed

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The Taira patent issued on December 26, 2000 and was filed on April 12, 1996. Applicants filed the present application on September 14, 2000. Therefore, the Taira patent can qualify as prior art, if at all, only under one or more of 35 U.S.C. § 102(e), (f), or (g). Moreover, the Taira patent is assigned on its face to Kabushiki Kaisha Toshiba, the same assignee as the present application. However, 35 U.S.C. § 103(c) states that the prior art under § 102(e) shall not preclude patentability of an invention if the invention was (1) developed by another person, and (2) commonly owned or subject to an obligation of assignment to the same person at the time the invention was made. The Taira patent meets both of these requirements, as Hideo Ando, a co-inventor of the present application, is not an inventor of the Taira patent, i.e., "another person" or inventive entity in the eyes of the law. Further, as noted above, both Taira and the present application were owned by or subject to an obligation of assignment to Kabushiki Kaisha Toshiba at the time the invention was made. Therefore, 35 U.S.C. § 103(c) operates to remove the Taira patent as available prior art in the present application.

The reference of Parulski cannot stand alone, as acknowledged by the Examiner and stated in page 4 of the Office Action on page 4. Without Taira, the 103(a) rejection of claims 29-38 cannot be maintained. Applicants respectfully request withdrawal of the Section 103(a) rejection of claims 29-38.

Applicants also respectfully traverse the Examiner's rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Taira and Ando. As

explained above, Taira cannot qualify as a prior reference under § 103(a). In addition, Ando does not qualify as a prior art reference under 35 U.S.C. § 103(a).

The Ando patent issued on January 23, 2007 and was filed on September 11, 2000. Applicants filed the present application on September 14, 2000. Inventors for both of the Ando patent and the present application are Hideo Ando and Masafumi Tamura. Therefore, the Ando patent cannot qualify as prior art under any section of § 102. Applicants therefore respectfully request the Examiner withdraw the rejection of claim 39.

### **Conclusion**

Applicants respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 29-39 in condition for allowance. Applicants submit that the proposed amendments of claim 39 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.


In view of the foregoing remarks, Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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